

TELEPHONE INTERVIEW SUMMARY

Applicants take this opportunity to thank the Examiner for the courtesy extended during the brief telephone interview held on October 24, 2003. Applicants appreciate the examiner's candor in explaining the scope of the search completed and the subject matter remaining for examination following the Examiner's determination to end his search of the inventive subject matter.

During the telephone interview, Applicants' counsel pointed out to the Examiner that the genus of claim 1 encompasses a total of 44 species in a Markush group. Applicants' counsel also pointed out to the Examiner that only two species remain in claim 1 as the Examiner proposes to restrict that claim. The Examiner stated that it would be burdensome to search more than two species already searched. No agreement was reached during the telephone interview that would place the remaining claims in condition for allowance.

REMARKS

Claims 1-19 are pending in this application. Claims 1-3 have amended. Claims 4-6 have been canceled, leaving claims 1-3 and 7-19 remaining. Claims 7-19 have been withdrawn, subject to Applicants request for rejoinder of the claims to a process for making the inventive compounds. Claims 4-6 have been canceled in the expectation that the amendments will place this application in condition for allowance.

The amendments do not introduce new matter within the meaning of 35 U.S.C. §132. Basis for the claim amendments is found on pages 3-7; in claims 1-19 as originally filed; and elsewhere throughout the specification and claims. Accordingly, entry of the amendments is respectfully requested.

Applicants take this opportunity to thank the Examiner for his indication of allowable subject matter in Claims 1 and 2, upon resolution of the issue of the restricted/non-elected subject matter.

1. Restriction

A. Initial Restriction Requirement. In the Office Action dated April 11, 2003, claims 1-19 were subjected to an election of species requirement, as well as the following restriction requirement:

Group I: Claims 1 and 2, products, variously classified.

Group II: Claims 7-19, various processes, variously classified.

Claims 3-6 were not grouped since the Examiner declared them to be non-statutory. Applicants responded to the Restriction/Election Requirement, electing Group I and the species corresponding to compound ii for examination. Based on the limited scope of the April 11, 2003 restriction, Applicants made their election of inventive group and species without traverse. Accordingly, claims 7-19 have been withdrawn by the Examiner.

Upon completion of prosecution of the compound claims, Applicants respectfully request rejoinder of claims 7-19, directed to a process for making the inventive compounds, which have the same limitations as, or are dependent from, the compound claims as ultimately allowed, under the mandatory rejoinder provisions of MPEP §821.04. Applicants respectfully request that the Examiner notify Applicants of the scope of allowed compound claims prior to issuance of a Notice of Allowance, so that appropriate amendments, if any are necessary, may be entered for the process claims.

B. New Restriction. In the Office action dated July 29, 2003, the Examiner has unilaterally imposed further restriction of claims 1 and 2, and has unilaterally made an election on Applicants' behalf, as follows:

In accordance with the restriction requirement of April 11, 2003, the examiner will identify a generic concept, inclusive of the elected species, for examination. The generic concept to be identified is that as found in claims 1-6 wherein (referencing claim1) Ar is the first appearing group, i.e. the RO-phenyl group, X is O and n is 2. The remaining subject matter, (other than that identified above) of claims 1 and 3-6 stands withdrawn as being for non-elected subject matter. Please note that the subject matter of claims 3-6 has now been included in the elected group. The subject matter of claim 2 of formulae I and ii is examined as being readable on the examined area identified above. The subject matter of claim 2 designated as iii through to and including X stands withdrawn as being for non-elected subject matter.

The withdrawn subject matter of claims 1-6 is properly restricted from the indicated examinable (elected) subject matter as if differs materially from same (the elected) so as to be patentably distinct. Firstly, note that the various depicted members of variable Ar are structurally different and as groups are subject to different classification areas, e.g. class 568-630, 549-356, 549-362, and 549-434. Secondly, the members of X are structurally different elements, O (oxygen) and N-CH₃, and are subject to different classification areas e.g. 544-106 and 544-358. Lastly the variable n results in structurally different compounds e.g. CH=CH (n=1) and CH=CH-CH=CH (n=2) and are recognized in different classification areas as note e.g. class 583-500 and 585-507. Additionally, electronic data base searching would require multiple varying structure inputs. As the various compounds covered by claims represent areas that are patentably distinct, restriction under 35 USC 121 is proper. Moreover, to not restrict as done herein would impose a burden on the search and/or the examination of this application.

C. Traversal. Applicants respectfully traverse this additional restriction for the following reasons:

First, the Examiner's unilateral imposition of a restriction without providing specific inventive groups and related

classification information, without providing any evidence supporting the claim of a serious burden, and without providing Applicants the opportunity to elect and/or traverse the restriction, fails to state a prima facie basis for restriction and violates Applicants due process rights. The restriction must be withdrawn for this reason alone.

Second, Applicants respectfully submit that the Examiner has no statutory or judicially created authority to define a subgeneric concept from Applicants' Markush group of inventive compounds and simply impose it upon Applicants. It is Applicants' right under 35 U.S.C. §112 to set the metes and bounds of their invention (*In re Wolfram*, 179 USPQ 620, 622 (CCPA 1973)). By imposing the new restriction, the Office Action has deprived Applicants of their statutory right under 35 U.S.C. §112 to "claims particularly pointing out and distinctly claiming the subject matter which Applicant regards as his invention." (Emphasis added). The Office cannot arbitrarily redefine an invention without Applicants' consent. Applicable case law has ruled that any attempt by the USPTO to object to a single claim as embracing more than one invention under 35 U.S.C. §121 violates the basic right of Applicants to claim their inventions as they choose (*In re Weber*, 198 USPQ 328,331-332 (CCPA 1978); *In re Haas*, 198 USPQ 334, 336 (CCPA 1978)).

It has been established practice since the 1978 decisions in *In re Weber* and *In re Haas* that it is improper for the USPTO to refuse to examine that which Applicants regard as their invention in every case in which the inventive subject matter has "unity of invention" under *In re Harnisch*, 206 USPQ 300 (CCPA 1980). *Harnisch* requires (1) a common utility and (2) at least one structural feature common to the species in a Markush group.

The inventive subject matter meets both prongs of the *Harnisch* test: the Markush groups in claims 1 and 2 each encompass compounds which have (1) a common utility: "thermogenic, pungent, spicy agents" useful as food additives, and (2) a common structural feature: all of the inventive compounds have (a) a six-membered heterocyclic morpholine or piperazine ring attached to (b) a six-membered aromatic ring which is, or is part of, a mono- or bicyclic ring moiety, linked together by (c) a 2,4-pentadienoic acid or 2-propenoic acid moiety. Thus, the Examiner has no discretion to refuse of examine the full scope of claim 1 under the guise of a purportedly burdensome search; burden is not a factor to be considered in dealing with a Markush group claim under *Harnisch*.

Third, the restriction is traversed because a search and examination of all, or at least a substantially greater portion, of the claimed compounds would not impose a serious burden on the Examiner. As noted above, there are 44 species within the Markush

genus of Formula I. Although the imposed restriction is incomplete in failing to state how many inventive groups the Examiner would define, it appears that the Examiner is asserting that there are 16. Applicants respectfully submit that the inventive compounds are properly classified in only **two** classification areas, subclasses 106 and 358 of class 544. Contrary to the Office Action, there is no basis in the record for any suggestion that all other classification areas must be searched for compounds within these classes. For example, absent a showing to the contrary by the Examiner, it appears unnecessary to search class 583, subclass 500 or class 585, subclass 507, which pertain to alkenes, when subclass 106 and 358 of class 544 are searched for the inventive aryl alkenoic acid amides.

A complete and thorough search of any one of the disclosed species would require searching the art areas appropriate to the other disclosed species. If a search and examination of an entire application can be made without **serious** burden, the Examiner **must** examine it on the merits (see MPEP §803).

In the present circumstance, where applicant has elected a single species for search, the Examiner's obligation is to begin the search with the elected species and expand the search until one of three events occurs: (1) a reference is found, (2) the complete genus is searched and found free of the prior art, or (3) the scope

of the search compels the conclusion that a full search would impose a serious burden on the Examiner. In the present case, a single search, covering only two species, did not find a reference or cover the genus, and does not satisfy the Examiner's obligation, as there is nothing in the record to show a **serious** burden.

On its face, dividing a genus of 44 inventive compounds into 16 patents, some of which would contain only or two species, violates the USPTO's own rules for proper restriction (MPEP §803; see also, USPTO Action Plan relating to restrictions in Technology Center 1600, published October 6, 2003). If the Examiner still feels that searching more than two species constitutes a serious burden, Applicants respectfully request that this matter be submitted for an analysis under the "second pair of eyes" review process under the Action Plan.

Finally, Applicants respectfully traverse the restriction requirement for the additional reason that Applicants have paid a filing fee for an examination of all the claims in this application. If the Examiner declines to examine the claims paid for when this application was filed, Applicants would have to pay duplicative fees when divisional applications are filed for the non-elected or withdrawn claims.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the restriction of claims 1 and 2.

2. Rejection of Claims 3-6 under 35 U.S.C. §112,

second paragraph

The Office Action rejects claims 3-6 under 35 U.S.C. §112, second paragraph, for the following reasons:

"The claimed subject matter is unclear as to meaning. The claims seem more to be statements as to what the compounds are useful for (claim 1) or what the compounds can be used as (claims 2 and 3), as opposed to clearly and distinctly pointing out what is to be claimed."

Claims 4-6 have been canceled. Claim 3 has been amended to state a claim to a method for flavoring food. These amendments obviate this rejection.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 3-6 under 35 U.S.C. §112, second paragraph.

3. Objection to Claims 1-2

The Office Action objects to claims 1-2 as containing non-elected subject matter. The Office Action further states that the claims limited to the elected and identified subject would appear allowable. Applicants have traversed the restriction of claim 1 to only two species, and incorporate the arguments and discussion above as the basis for traversing the withdrawal of any subject matter. Applicants respectfully submit that the scope of unamended claims 1 and 2 is reasonable, and lacking any proper basis for

restriction, is allowable.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the objection to claims 1-2.

CONCLUSION

Based upon the above remarks, the presently claimed subject matter is believed to be novel and patentably distinguishable over the prior art of record. The Examiner is therefore respectfully requested to reconsider and withdraw the rejections of remaining claims 1-3 and 7-19, to allow pending claims 1-3 presented herein for reconsideration, and to rejoin process claims 7-19. Favorable action with an early allowance of the claims pending in this application is earnestly solicited.

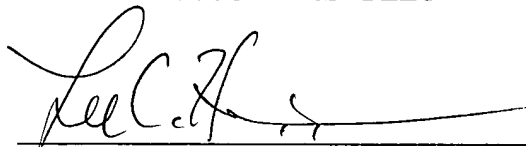
The Examiner is welcomed to telephone the undersigned attorney if he has any questions or comments.

Respectfully submitted,

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